

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex Parte Alexander B. BEAMAN

Application for Patent: 10/623,339

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Examiner: Steven B. Theriault

For:

VOICE MENU SYSTEM

APPEAL BRIEF

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Signed: /Lydie Fitzsimmons/
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1. REAL PARTY IN INTEREST

The real party in interest is the assignee Apple Inc. of Cupertino, CA.

2. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

3. STATUS OF CLAIMS

The following claims have been rejected and appealed: claims 1-32.

The claims on appeal are reproduced below in the Appendix at Section 9 of this Appeal Brief.

4. STATUS OF AMENDMENTS

No amendments were filed subsequent to final rejection.

5. SUMMARY OF CLAIMED SUBJECT MATTER

5.1. Independent Claim 1

Claim 1 pertains to a method for providing an audio menu. This method includes providing text strings on a server, each text string capable of presenting a menu choice. This is described in the application at FIG. 3, step 305 and paragraph [0024]. The method also includes generating audio files, each audio file representing a voiced name of one of the text strings. This is described in the application at FIG. 3, step 310 and paragraph [0025]. Then each of the audio files are associated with the text string associated thereto. This is described in the application at FIG. 4, step 430 and paragraph [0028]. Then the audio files are delivered to a client from the server. This is described in the application at FIG. 3, step 315 and paragraph [0031]. Then a menu is presented to the client that includes menu choices represented by the text strings, the menu choices being capable of being highlighted or selected. This is described in the application at FIG. 3, step 325 and paragraph [0032]. Then the audio file is played on the client when the associated menu choice is highlighted. This is described in the application at FIG. 3, step 330 and paragraph [0032].

5.2. Independent Claim 8

Claim 8 describes a method for creating audio menu components, wherein the audio menu components represent navigational components directed to the selection of media content. The method includes providing a text string that represents a menu component, whereby the menu component is one of several options that can be selected from a displayed menu on a client device. This is described in the application at FIG. 3, step 305 and paragraph [0024]. The method also includes generating an audio file that is an audio representation of the menu component. This is described in the application at FIG. 3, step 310 and paragraph [0025]. The method then includes delivering the audio file to a client device. This is described in the application at FIG. 3, step 315 and paragraph [0031].

5.3. Independent Claim 16

Claim 16 describes a server. The server includes a processor, which is described in the application in FIG. 7, component 705, and paragraph [0042] and [0043]. The server also includes a memory operably connected with the processor. This is described in the application in FIG. 7, component 715, and paragraph [0042]. The processor is operable to perform instructions including providing a text string that represents a menu component, wherein the audio menu components represent navigational components directed to the selection of media content. This is described in the application at FIG. 3, step 305 and paragraph [0024]. The processor is also capable of generating an audio file that is an audio representation of the menu component. This is described in the application at FIG. 3, step 310 and paragraph [0025]. The processor is also capable of then delivering the audio file to a client device. This is described in the application at FIG. 3, step 315 and paragraph [0031].

5.4. Independent Claim 20

Claim 20 describes a client device. The client device includes a processor, which is described in the application in FIG. 7, component 705, and paragraph [0042] and [0043]. The client device also includes a memory operably connected with the processor. This is described in the application in FIG. 7, component 715, and paragraph [0042]. The processor is operable to perform instructions including receiving an audio file that is an audio representation of a menu component, wherein the audio menu components represent navigational components directed to the selection of media content. This is described in the application at FIG. 3, step 320 and paragraph [0032]. The processor is also capable of updating the menu to include

the menu component. This is described in the application at FIG. 3, step 325 and paragraph [0032]. The processor is also capable of playing the audio file on the client when the associated menu choice is highlighted. This is described in the application at FIG. 3, step 330 and paragraph [0032].

5.5. Independent Claim 21

Claim 21 pertains to a media management system. The system includes a media database that stores media files. This is described in the application at FIG. 2, component 210 and paragraph [0017]. The system also includes media collection records that include data relating to groupings of the media files. This is described in the application at FIG. 2, component 225 and in paragraph [0017]. The system also includes media records that include metadata relating to the media files. This is described in the application at FIG. 2, component 220, and paragraph [0016]. The system also includes a voiced names database that stores audio files. This is described in the specification at FIG. 2, component 215, and paragraph [0023]. The system also includes association records that associate the audio files with data from the media collection records and metadata from the media records. This is described in the specification at FIG. 2, component 230, and paragraph [0023].

5.6. Independent Claim 26

Claim 26 describes a client device. The client device includes a processor, which is described in the application in FIG. 7, component 705, and paragraph [0042] and [0043]. The client device also includes a memory operably connected with the processor. This is described in the application in FIG. 7, component 715, and paragraph [0042]. The memory stores media content and metadata for a plurality of media items and also stores audio content representing the metadata for the media items. These are described as records 220, 225, and 230 in FIG. 2 and the corresponding text. The processor is operable to perform instructions including receiving a selection of one of the media items and then playing the audio content for at least a portion of the metadata representing the selected one of the media items. This is described in the application at FIG. 3, step 330 and paragraph [0032].

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Rejection of claims 1-2, 4, 8-29 under 35 U.S.C. 102(e) as being anticipated by Born et al. (U.S. Pub. 2005/0045373).

B. Rejection of claim 3 under 35 U.S.C. 103(a) as being unpatentable over Born et al. (U.S. Pub. 2005/0045373) in view of Gallenson et al. (WO 01/30046).

C. Rejection of claims 5-7 and 30-32 under 35 U.S.C. 103(a) as being unpatentable over Born et al. (U.S. Pub. 2005/0045373) in view of Swanson et al. (U.S. Pub. 2002/0013784).

7. ARGUMENT

A. Rejection of claims 1-2, 4, 8-29 under 35 U.S.C. 102(e) as being anticipated by Born et al. (U.S. Pub. 2005/0045373).

The main issue on Appeal is the effectiveness of the Affidavit filed on 10/11/2007. This affidavit was submitted to establish conception of the invention prior to the effective date of the Born et al. reference and to establish subsequent diligence in constructively reducing the invention to practice by virtue of filing the present patent application.

The Affidavit presents facts that the invention was conceived no later than March 3, 2003. The Examiner does not challenge this conception date, and as such Applicant does not believe that this fact is at issue in this Appeal.

The Affidavit establishes diligence in constructively reducing the invention to practice via several facts. Specifically, the Affidavit establishes that the invention was submitted to the online patent disclosure repository of Apple Computer, Inc. on March 3, 2003, that from March 3, 2003 to May 20, 2003, Apple Computer, Inc's patent review committee was diligently evaluating the proposed idea to determine whether to file a patent application on it, and that on May 20, 2003, Apple Computer, Inc. sent a letter to Patent Attorney Doug Thomas requesting an estimate for the cost of preparing a patent application and a sample claim. The Affidavit also establishes that the inventor then began working with Mr. Thomas to prepare the actual application.

The Examiner argues that this fails to establish diligence in reducing the invention to practice for two reasons. First, the Examiner argues that the May 20, 2003 letter to Mr. Thomas states that authorization to proceed with the application would only occur once a sample claim and an estimate were provided by Mr. Thomas. The Examiner apparently feels that the time that Mr. Thomas spent preparing an estimate and preparing a sample claim does not constitute reasonable diligence. Second, the Examiner argues that the time the Apple patent review committee spent reviewing the proposed idea suggests a period of inactivity in order to exploit the invention commercially rather than diligence in reducing the invention to practice. Applicant strongly disagrees with both points for the following reasons.

As to the Examiner's first point, the Applicant respectfully asserts that preparing of an estimate and a sample claim for an invention is diligently reducing the invention to practice. The fact that final authorization to complete the entire task of preparing and filing the patent application is held back until an estimate is given and sample claims reviewed is not relevant to the analysis. The M.P.E.P. does not require that the Applicant follow the conception date by immediately grant an attorney full authority to file an application in the USPTO. The M.P.E.P. requires only that the Applicant act with reasonable diligence. Requesting that an attorney review a written disclosure, draft a sample claim, and provide a cost estimate are reasonably diligent steps to take during the preparation of a patent application. It should also be noted that the attorney's work in performing these acts would involve learning about the patent application and undertaking an analysis of the complexity and feasibility of obtaining patent protection, also reasonable steps to take during the preparation of a patent application. Preparing a patent application is an expensive process, and one that is not undertaken lightly, as such it is not only reasonable but expected that an applicant would want to obtain a cost estimate and a sample claim to review prior to committing to such an expensive proposition.

As to the Examiner's second point, the Examiner has assumed facts not in evidence and indeed the facts the Examiner has assumed are incorrect. The Examiner apparently is unfamiliar with what a patent review committee is and what they do. All large corporations that pursue large numbers of patents have committee set up to determine which ideas to patent and which ideas are not worth patenting. As one could imagine, a company as large as Apple Computer has a large number of employees who conceive of an extremely large number of potentially patentable

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ideas. A patent review committee is a mechanism companies use to help facilitate the process of pursuing patents, by filtering out the ideas to pursue as patents from the ones that should not be pursued. A number of factors go into this analysis, including the patentability of the idea, the cost of pursuing patent protection, the potential benefit to the company, etc. These analyses are reasonably diligent steps to take in securing patent protection.

There is no evidence at all to support the Examiner's suggestion that the time taken by the patent review committee to review the idea represents a period of inactivity to exploit the invention commercially. Indeed, such an assumption is quite unreasonable. If such an assumption were taken as fact, then no large companies would be able to obtain patent protection as any time spent by a patent review committee would be deemed to be lack of reasonable diligence. Indeed, such an assumption would render a large percentage of outstanding patents invalid.

Furthermore, Apple Computer is not a small company and is not a company that keeps its products secret. Indeed, Apple Computer, as the Examiner is well aware, is involved in the mass marketing of products to consumers around the world. If the Examiner truly believes that attempts were made to commercially exploit the invention between March 3, 2003 and May 20, 2003, the Examiner would certainly be able to find evidence of such a commercial exploitation (e.g., a press release describing a new product, a product manual, newsgroup discussions of the product). No such evidence has been presented by the Examiner, because in fact the invention was not commercially exploited during that period.

Indeed, it is perplexing to the Applicant that the Patent Office is arguing that acts taken to determine patentability of a potential idea do not represent reasonable diligence in reducing the invention to practice. Not only are such acts reasonable, but recently proposed legislation from the PTO suggests that in fact the PTO would prefer that the Applicant perform significant pre-filing acts to determine the patentability of a patent application, including, for example, preparation of a report outlining the patentability of each submitted claim.

The M.P.E.P. only requires that an Applicant undertake reasonable diligence in reducing an invention to practice. The Examiner, on the other hand, appears to be requiring exceptional diligence. Indeed, judging by the Examiners standard of diligence, Applicant believes the only way that Apple Computer could have convinced the Examiner of the diligent reduction to practice of the invention would

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be to conceive of the invention one day, hire an attorney and authorize him to prepare the application the very next day, and then file the application within a week. Such a standard, however, is unreasonable.

The Examiner argues that "[w]hile the statement made by the applicant attests to diligence during the periods of March 3-May 20, 2003 and May 20, 2003-July 18, 2003, the Exhibit contains no evidence or facts to support the assertion." Applicant strongly disagrees. The diligence during the period of March 3-May 20, 2003 is established via the fact described in the Exhibit that during this period the application was under review by a patent review committee. The Examiner does not challenge the fact that the application was indeed being reviewed by the patent review committee during this time, the Examiner is merely questioning whether this review constitutes enough diligence in reducing the invention to practice. As such, it is incorrect for the examiner to say that the Exhibit contains no evidence or facts to support diligence, its just that the Examiner is unsatisfied with the level of diligence he believes these presented facts show. Likewise, the diligence during the period of May 20, 2003 - July 18, 2003 is established via the fact described in the Exhibit that requesting that sample claims be drafted prior to further authorization to proceed being given. Again, the Examiner does not challenge the fact that the sample claims were indeed being drafted and reviewed during this time, the Examiner is merely questioning whether these actions constitute enough diligence.

The Applicant maintains that the facts presented in the Affidavit, which are undisputed by the Examiner, are sufficient under the standards promulgated by the M.P.E.P. to establish diligence in reducing the invention to practice during all the time periods at issue.

B. Rejection of claim 3 under 35 U.S.C. 103(a) as being unpatentable over Born et al. (U.S. Pub. 2005/0045373) in view of Gallenson et al. (WO 01/30046).

The rejection of claim 3 is appealed for the same reasons as described above with respect to claims 1-2, 4, and 8-29.

C. Rejection of claims 5-7 and 30-32 under 35 U.S.C. 103(a) as being unpatentable over Born et al. (U.S. Pub. 2005/0045373) in view of Swanson et al. (U.S. Pub. 2002/0013784).

The rejection of claims 5-7 and 30-32 is appealed for the same reasons as described above with respect to claims 1-2, 4, and 8-29

For the above reasons, Applicant respectfully asserts that the Affidavit is valid and the underlying rejection should be withdrawn.

I am the attorney or agent acting under 37 CFR 1.34

8. CONCLUSION

In view of the foregoing, it is respectfully submitted that the Examiner's rejection of claims 1-32. Accordingly, the rejections should be reversed.

Respectfully submitted,
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9. CLAIMS APPENDIX

CLAIMS ON APPEAL

1. A method for providing an audio menu, comprising:
 - providing text strings on a server, each text string capable of representing a menu choice;
 - generating audio files, each audio file representing a voiced name of one of the text strings;
 - associating each of the audio files with the text string corresponding thereto;
 - delivering the audio files to a client from the server;
 - presenting a menu on the client that includes menu choices represented by the text strings, the menu choices being capable of being highlighted or selected;
 - playing the audio file on the client when the associated menu choice is highlighted.
2. The method of claim 1, further comprising:
 - providing a remote control that can navigate through the menu on the client.
3. The method of claim 1, wherein:
 - the voiced names are in a language other than English.
4. The method of claim 1, wherein:
 - the client is capable of playing music; and
 - playing the audio file when music is playing does not stop the music from playing.
5. The method of claim 4, wherein:
 - the client produces audio output in at least two channels; and
 - the audio file is output through only one channel.
6. The method of claim 5, wherein:
 - exactly two channels are used for the client's audio output, the two channels being a left channel and a right channel.

7. The method of claim 4, wherein:
the audio file is mixed with the music when the music is playing.
8. A method for creating audio menu components, wherein the audio menu components represent navigational components directed to the selection of media content, comprising:
providing a text string that represents a menu component, whereby the menu component is one of several options that can be selected from a displayed menu on a client device;
generating an audio file that is an audio representation of the menu component;
delivering the audio file to a client device.
9. The method of claim 8, further comprising:
playing the audio file; and
requesting approval of the played audio file prior to delivering the audio file to a client device.
10. The method of claim 9, wherein:
generating the audio file is accomplished via a text-to-speech algorithm.
11. The method of claim 10, wherein:
if approval is not given, providing an opportunity to modify the text string;
and
if the text string is modified,
replacing the audio file with a new audio file generated from the modified text string,
playing the audio file, and
requesting approval of the played audio file.
12. The method of claim 11, wherein:
if the text string is not modified, providing an opportunity to replace the audio file with a new audio file generated from an audio recording.

13. The method of claim 8, wherein:
the audio file generation includes at least compression of the audio file.
14. The method of claim 8, wherein:
the delivery of the audio files includes embedding the audio files in metadata.
15. The method of claim 8, further comprising:
determining whether the audio file is present on the client device;
wherein, delivering the audio files is performed only if the audio file is not
present on the client device.
16. A server comprising:
a processor; and
memory, operably connected with the processor;
wherein the processor is operable to perform instructions including
providing a text string that represents a menu component, wherein the
audio menu components represent navigational components directed to the
selection of media content;
generating an audio file that is an audio representation of the menu
component;
delivering the audio files to a client device.
17. A method of using audio files in a menu comprising:
receiving an audio file that is an audio representation of a menu component,
whereby the menu component is one of several options that is selectable from the
menu; and
playing the audio file when the menu component is chosen.

18. The method of claim 17, wherein:
the menu includes menu components that have not been received; and
pre-packaged audio files are associated with the menu components that have not been received.
19. The method of claim 17, wherein:
the audio file is played only after the menu component has been highlighted for a predetermined period of time.
20. A client device comprising:
a processor; and
a memory, operably connected with the processor;
wherein the processor is operable to perform instructions including
receiving an audio file that is an audio representation of a menu component, wherein the audio menu components represent navigational components directed to the selection of media content;
updating the menu to include the menu component
playing the audio file when the menu component is chosen.
21. A media management system comprising:
a media database that stores media files;
media collection records that include data relating to groupings of the media files;
media records that include metadata relating to the media files;
a voiced names database that stores audio files; and
association records that associate the audio files with data from the media collection records and metadata from the media records.
22. The media management system of claim 21, wherein:
the media management system is executed on a portable digital music player.

23. The method of claim 17, wherein the audio file is received from a server.
24. The method of claim 17, wherein the menu component is highlighted when chosen.
25. The method of claim 17, wherein said method further comprises:
updating the menu to include the menu component.
26. A client device comprising:
a processor; and
a memory, operatively connected with the processor, the memory storing media content and metadata for a plurality of media items, the memory also storing audio content representing the metadata for the media items;
wherein the processor is operable to perform instructions including receiving a selection of one of the media items and then playing the audio content for at least a portion of the metadata representing the selected one of the media items.
27. A client device as recited in claim 26, wherein the processor is further operable to perform instructions including playing the media content for the selected one of the media items concurrently with the playing the audio content for at least the portion of the metadata associated with the selected one of the media items.
28. A client device as recited in claim 26, wherein the processor is further operable to:
present a menu on the client that includes menu choices represented by the text strings, the menu choices being capable of being highlighted or selected; and
play the audio file on the client when the associated menu choice is highlighted.
29. A client device as recited in claim 28, wherein the processor is further operable to:
receiving instructions from a remote control to navigate through the menu.

30. A client device as recited in claim 26, wherein the processor is further operable to:

produce audio output in at least two channels; and
wherein the audio file is output through only one channel.

31. A client device as recited in claim 26, wherein exactly two channels are used for the client's audio output, the two channels being a left channel and a right channel.

32. A client device as recited in claim 31, wherein the processor is further operable to:

mix the audio file with the media item when the media item is playing.

10. EVIDENCE APPENDIX

No evidence has been submitted pursuant to §§ 1.130, 1.131, or 1.132 of 37 CFR, nor has any other evidence been entered by the examiner.

11. RELATED PROCEEDINGS APPENDIX

There have been no decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of 37 CFR 41.37(c)(1).